

## **REMARKS**

The Examiner requires confirmation of an election made by Applicant. The Examiner rejected Claims 1, 6, 9, 14, 32 and 33 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No.6,689,155. The Examiner rejected Claim 21 under 35 U.S.C. § 102(e) as being anticipated by Patent Number 5,674,269 (Augustine). Such rejections are noted. The Examiner objected to Claims 8, 11-13, 16, 19, 28-31, and 34 as being dependent upon a rejected base claim.

Claims 21, 22, 23, 26, and 35 have been cancelled, without prejudice. Applicants respectfully submit that Claims 1, 6, 8, 9, 11-14, 16, 19, and 28-34 are allowable.

### **Election of Claims**

The Examiner identified three distinct inventions. In a telephone conversation between the Examiner and Applicants' representative, Thomas A. Kulaga, Applicant's representative elected invention I embodied in Claims 1, 6, 8, 9, 11-14, 16, 19, 21, and 28-34 drawn to a therapy device. Applicants hereby affirm that election in this response and cancel the claims embodying inventions II and III identified by the Examiner.

### **Rejection under the judicially created doctrine of obviousness-type double patenting**

The Examiner rejected Claims 1, 6, 9, 14, 32, and 33 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent Number 6,689,155. Applicants respectfully submit that the claims in this application have a different scope than those of Patent Number 6,689,155 and that, as such, the Terminal Disclaimer is not necessary. However, for the sake of expediting the allowance of this application and to reduce prosecution expenses, filed herewith is a Terminal Disclaimer along with the required fee under 37 C.F.R. 1.20(d). Applicants respectfully request the Examiner withdraw the rejection of Claims 1, 6, 9, 14, 32, and 33.

### Rejection Under 35 U.S.C. § 102(e)

Addressing the Examiner's rejection of Claim 21 under 35 U.S.C. § 102(e), Applicants respectfully suggest that Augustine (Patent Number 5,674,269) does not anticipate the claims of the present invention. Section 2131 of the Manual of Patent Examining Procedure describes the basis for anticipation under 35 U.S.C. § 102. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

With respect to Claim 21, the Examiner states:

Regarding claim 21, Augustine discloses a therapy device for providing heated air to a patient's upper body, said device comprising: a means (108) for releasably containing a first quantity of a medium; a means (103a) for connecting a source of said first quantity of said medium to said means for containing; a means (109) for exhausting a second quantity of said medium from said means for containing; a means (the u-shape of 108 in combination with the covering sheet 11 8) for securing said means for containing in a fixed position adjacent to an upper body member; and a means (109 in combination with 118) for directing said second quantity of said medium over said upper body member, see col. 1-6, particularly col. 3, line 34 through col. 5, line 13 and col. 6, lines 19-55 and figures 1-5.

Paper Number 200505312, Application Serial No. 10/774,816, at 5-6.

Claim 21 includes means-plus-function limitations, as defined by 35 U.S.C. § 112, sixth paragraph. A means-plus-function limitation must be interpreted to cover the corresponding structure, materials, or acts in the specification and "equivalents thereof." 35 U.S.C. § 112, sixth paragraph; *see also* MPEP § 2181. The Examiner "must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, **in light of and consistent with the written description of the invention in the application.**" MPEP 2181, sub-section I, pg. 2100-220, 8th ed., rev. 2 (emphasis added).

Applicants respectfully submit that Augustine does not disclose any equivalent structures corresponding to those disclosed in Applicants' specification, and, therefore, Augustine does not teach every element of the claimed invention. However, for the sake of expediting the allowance of this application and to reduce prosecution expenses, Applicants have cancelled Claim 21, without prejudice.

### **Claims with Objections**

The Examiner objected to Claims 8, 11-13, 16, 19, 28-31, and 34 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all the limitations of the base claim and any intervening claims. Because of the Terminal Disclaimer submitted in response to the rejections by the Examiner, Applicants respectfully submit that Claims 8, 11-13, 16, 19, 28-31, and 34 are in condition for allowance. However, if for some reason the Examiner maintains the rejection of the independent claims, Applicants reserve the right to rewrite the claims in independent form.

### **Conclusion**

In view of the cancellation of Claims 21, 22, 23, 26, and 35, without prejudice, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the Examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910 (27230.03).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas A. Kulaga". The signature is fluid and cursive, with the first name "Thomas" and last name "Kulaga" clearly distinguishable.

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